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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,700	05/22/2006	Takashi Sugibuchi	58866US004	2986
32692 7590 12/01/2008 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
EXAMINER				
AHMED, SHEEBA				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
12/01/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com
LegalDocketing@mmm.com

Office Action Summary

Application No.

10/563,700

Applicant(s)

SUGIBUCHI, TAKASHI

Examiner

SHEEBA AHMED

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendments to claims 6 and 7 have been entered in the above-identified application. Claims 1-5 are cancelled. **Claims 6-9 are pending.**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5,888,625 A) in view of Ozdeger (US 6,420,480 B1).

Kobayashi et al. disclose an image recording paper comprising a substrate and a coating of a silicone compound and a finely divided material. The coating preferably contains besides the silicone compound a modified-silicone oil having in a molecule thereof a reactive group and this image recording paper eliminates a conflict between fixability and releasability of an image forming material and is easily reusable without altering the appearance of plain paper. The reusable recording paper comprises a substrate comprised primarily of a pulp fiber and a film thereon which is created by coating or impregnating the substrate with a liquid composition comprising a silicone compound and a finely divided material and thereafter drying the applied composition, wherein the silicone compound is capable of combining with the substrate and with the

finely divided material by a chemical reaction. The film component containing the curable silicone compound strongly adheres to the substrate and does not come off the substrate (pulp fiber) while functioning as a release providing coating to an image forming material. That is, the film component does not migrate. Accordingly, it not only facilitates the removal of the image forming material but also semipermanently exhibits its function in the reusable recording paper. Besides, owing to the finely divided material which makes it possible to control the surface irregularity of the film so that the amount of remnant image forming material at the time of removal of the image forming material is reduced, the performance of the film can be maintained for a long period of time. The thickness of the coated film is preferably in the range of 0.05 to 5.0 microns, exclusive of the thickness of the finely divided material. The amount of finely divided material as calculated with respect to the amount of the silicone compound is preferably in the range of 1 to 100 parts by weight of the finely divided material per 100 parts by weight of the silicone compound and the average particle diameter of the finely divided material is preferably in the range of 0.1 to 15 microns. EXAMPLE 2 recites a coating liquid containing 14 parts of silicone resin particles (TOSPEARL 130 having an average particle diameter of 3 microns) as a finely divided material.

Kobayashi et al. do not teach that their substrate can be a plastic base film.

However, Ozdeger discloses silicone acrylate latex polymers and in particular silicone acrylate latex polymers used as release coatings (See Abstract). A coated sheet material is provided comprising a flexible sheeting and a release coating covering at least a portion of one major surface of the flexible sheet wherein the

release coating is formed by coating the waterborne silicone acrylate latex polymer, which has been diluted as necessary for coating. The coated article thus obtained possesses excellent release, writability, printability, and aging properties. Typical substrates include solid substrates, such as a sheet, a fiber or a shaped object. However, the preferred substrates are those that are typically used for pressure-sensitive adhesive products. Such substrates include but are not limited to paper, metal sheets and foils, nonwoven fabrics, cellophane, films of thermoplastic resins such as polyesters, polyamides, polyolefins, polycarbonates, polyvinyl chloride, and acetate films (See Column 8, lines 28-40).

Accordingly, it would have been obvious to one having ordinary skill in the art to replace the paper substrate taught by Kobayashi et al. with a plastic base film given that Ozdeger teaches that paper and plastic substrates function as equivalents as substrates for release coatings.

Response to Arguments

3. Applicant's arguments with respect to claims 6-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEEBA AHMED whose telephone number is (571)272-1504. The examiner can normally be reached on Monday-Friday from 8am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sheeba Ahmed/
Primary Examiner, Art Unit 1794